

Appln No. 09/711,648

Amdt date June 1, 2004

Reply to Office action of December 29, 2003

REMARKS/ARGUMENTS

Claims 1-41 now remain pending in this application. At the outset, Applicants notes that claims 8, 14 and 19 have been amended, without prejudice, solely to correct minor, inadvertent, typographical errors. In response to the Office action dated December 29, 2003, Applicants have amended claims 1, 9, 12, 17, 19, 21-23, 29, 30, 32 and 34 to better define the patentable subject matter thereof. Applicants have also introduced new claims 36-41, each of which is dependent. The amendments find full support in the original specification, claims and drawings. No new matter is presented. Applicants respectfully submit that all of claims 1-41 are now in condition for allowance. Accordingly, Applicants respectfully request favorable reconsideration and a timely indication of allowance.

In the Office action dated December 29, 2003, the Examiner rejected claims 1, 5-12, 23, 25 and 27-29 under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 5,370,675 to Edwards et al. ("Edwards '675"). Applicants have now amended independent claims 1 and 9 to recite an injection catheter having an injection needle whose distal end can extend either distally beyond the distal end or out the distal face of the tip section, which are features neither taught nor suggested by Edwards '675. In that regard, Edwards '675 inappositely disclosed angled stylet ports that are located in the side wall of the stylet guide housing and proximal to the terminal portion of the probe, which generally preclude the stylet(s) extending distally out of a distal face or beyond a distal end of the terminal portion of the probe. Clearly, none of the multiple

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configurations disclosed by Edwards '675 uses a stylet that extends distally beyond a distal end or out a distal face of the probe. And, because Edwards '675 focused primarily on ablating tissue in and around the urethra, Edwards '675 taught primarily the use of a dilation balloon 30 at the terminal portion, presumably to facilitate the stylets penetrating and/or ablating the tissue in and around the urethra. (See, e.g., Col. 6, 56-60.) Indeed, as best illustrated in Figs. 1 and 2 of Edwards '675, a stylet extending distally beyond a distal end or out a distal face of the terminal portion of the probe would undesirably extend into the bladder or simply fail to contact, much less penetrate, any tissue in or around the urethra. As such, Applicants respectfully submit that Edwards '675 cannot possibly anticipate amended claim 1 or claim 9, nor could it have rendered these claims obvious.

Applicants further note that the probe in Edwards '675 is passed upwardly through the urethra (see, Col. 6, lines 41-43) and then rotated about its central axis prior to deployment of the stylet(s) (see, Col. 9, lines 42-44). Applicants submit that this approach taught away from Applicants' claims 1 and 9 because the mere passage and rotation of the probe as taught by Edwards '675 could not have resulted in effective tissue contact or penetration by the stylets had the stylets extended distally beyond a distal end or out a distal face of the terminal portion of the probe. Thus, the teaching of Edwards '675 further reinforces the conclusion that Edwards '675 neither anticipated nor could have rendered obvious Applicants' claims 1 and 9.

Appln No. 09/711,648

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Given the foregoing remarks, Applicants submit that independent claims 1 and 9 are patentable. Moreover, Applicants submit the foregoing remarks in support of dependent claims 2-8, 12-16, 21, 30, 31, 36 and 37 which depend from claim 1, and also in support of dependent claims 10-11, 17-20, 22, 32, 33, 38, 39 which depend from claim 9. Selected of these claims have been amended to further define the patentable subject matter.

Applicants have also amended independent claim 23 to recite an injection catheter having an injection needle whose distal end can extend distally out the distal face of the catheter body. For the reasons stated above, Applicants respectfully submit that claims 23 and depending claims 24-29, 34, 35, 40 and 41 define patentable subject matter over Edwards '675. Despite the language in Edwards '675 stating that "other stylet arrays such as a longitudinal array or a spiral array can also be used" (Column 14, lines 53-60), it bears repeating that nowhere did Edwards '675 disclose the use of stylet(s) whose distal ends can extend distally out the distal face of the catheter body. As stated above, the teachings of Edwards '675 are generally limited to stylets that extend from ports located in the side wall of the probe at locations proximal of the terminal portion. This holds true whether the probe of Edwards '675 is for use in the urethra or elsewhere in the human body.

Moreover, Edwards '294 shares the shortcomings of Edwards '675 since it also focuses primarily on the treatment of tissue in or around the urethra. It therefore is similarly inapposite to Applicants' claimed invention because it taught away from injection catheters with an injection needle whose distal end

Appln No. 09/711,648

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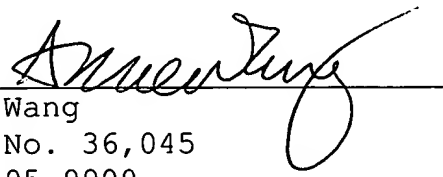
Reply to Office action of December 29, 2003

extends distally out the distal face of the catheter body. Edwards '284, too, disclosed no more than the use of a dilation balloon 30 at the terminal portion of the probe thereby precluding any stylet from extending distally beyond a distal end or out a distal face of the terminal portion.

The foregoing arguments are further submitted in support of new claims 36-41, each of which is depending from claim 1, 9 or 23.

In view of the above amendments and remarks, Applicant respectfully submits that all of pending claims 1-41, as amended are in condition for allowance. Applicant therefore respectfully requests a timely indication of allowance. If there are any remaining issues that can be addressed by telephone the Examiner is invited to contact the undersigned at the number indicated below.

Respectfully submitted,
CHRISTIE, PARKER & HALE, LLP

By 
Anne Wang
Reg. No. 36,045
626/795-9900

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